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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PANKAJ SHRIVASTAVA, GREGORY GOODHUE,
ATA KHAN, ZHIMIN DING, and CRAIG MACKENNA

Appeal 2009-004658
Application 10/566,515
Technology Center 2100

Before JAMES T. MOORE and ALLEN R. MACDONALD, *Vice-Chief Administrative Patent Judges*. LANCE LEONARD BARRY, JEAN R. HOMERE, and JAMES R. HUGHES, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

In a paper filed May 24, 2010, Appellants request a rehearing under 37 C.F.R. § 41.52 from the Decision of the Board of Patent Appeals and Interferences (hereinafter Board) dated March 26, 2010. In the Decision, an initial panel of the Board affirmed the Examiner's rejection of claims 1-21. Appellants presently allege that the Board erred by misconstruing Mitsuhira's teachings (Req. Reh'g. 2-3), and by introducing a new ground of rejection without so designating it in the Opinion. (*Id.* at 4-7.) We summarize Appellants' principal allegations of error as follows:

(1) Mitsuhira's registers are general registers that are internal to a computer, whereas the special function registers recited in independent claim 1 are registers that are internal to a processor chip within a computer. (*Id.* at 2-3.);

(2) Rather than deciding the appeal based on the specific reasoning presented in the Examiner's rejection, the Board made a new finding of facts upon which the Board decided the appeal. The Board improperly affirmed the Examiner's rejection based on the new fact finding, without designating it as a new ground of rejection. Consequently, the Board has not afforded Appellants a fair opportunity to address the new finding of facts upon which the conclusion for the affirmance is premised. (*Id.* at 4-7.)

Consequently, Appellants request that the Board reverse the Examiner's rejection, and designate the Board's rejection as a new ground of rejection. (*Id.* at 7-8.)

We have carefully reviewed the Decision in light of Appellants' allegations of error. We will address those remarks in the order in which they are presented in the Request, and outlined above.

1. Regarding Appellants' first allegation of error, Appellants appear to be attempting to distinguish the claimed registers from Mitsuhira's based on what they represent, as opposed to what they actually do. Such argument is unavailing. In the Decision's original analysis, the panel found that Mitsuhira teaches a computer having a plurality of register bank blocks, which are used to perform various storage functions while the computer is performing an arithmetic operation. (Op. 6, FF.)

We reiterate the observation first made by the panel that nowhere in the record before us did Appellants point out or provide persuasive evidence to substantiate their allegation that the special function registers are well-known as registers that are included on a processor chip. While Appellants' specification generally discusses embodiments wherein special function registers (SFRs) are included in a processor and in a bridge, we have not been directed to, and can find nowhere in the Specification an expressed definition of SFRs or any indication that they are defined as registers that are included in devices such as a processor chip. (Spec. para. [0021, 0030].) Further, while we agree with Appellants that "special function register" is a term of art, the Appellants have not provided persuasive evidence to establish, and we were unable to verify, the Appellants' proffered definition after consulting various computer dictionaries. Thus, we broadly construed the term special function register as a register for storing certain functions. Consequently, we found that since Mitsuhira's registers can be used to store certain functions while the computer is performing an arithmetic or logical operation, these registers teach the claimed SFRs. (Op. 6.)

Additionally, we agree with the panel's initial position that the claim does not require that the recited system include a plurality of special

function registers. Rather, the claim requires that the system include register blocks to be used as special function registers by a processor during logical or arithmetic operations. (*Id.*) As detailed in the Decision, such recitation is not entitled to any patentable weight since it is a statement of intended use (i.e. intent to use the registers as SRFs,) which is fully met by an anticipating prior art structure that is capable of performing those intended uses. We note that "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Therefore, we maintain the panel's initial position that since Mitsuhira's registers are capable of being used to store certain functions while the computer is performing a logic or arithmetic operation Mitsuhira's disclosure teaches the disputed limitations. (*Id.*)

2. Regarding Appellants' second allegation of error, we agree with Appellants that by premising the affirmance on finding of facts not particularly discussed by the Examiner during prosecution, the panel changed the thrust of the Examiner's rejection. In the interest of providing Appellants with a fair opportunity to address this modified conclusion of obviouness, we are herein modifying the initial Decision as follows:

We designate the modification of the Examiner's rejection as a new ground of rejection.

CONCLUSION

In view of the foregoing discussion, we grant Appellants' Request for Rehearing. We have altered the original Decision by designating the

modification of the Examiner's rejection as a new ground of rejection. While we have modified the analysis in the Decision, we have maintained our decision to affirm the Examiner's obviousness rejection of claims 1-21.

This Decision on Request to Rehearing has substantially modified the original Decision as to become a new Decision. Pursuant to 37 C.F.R. §§ 41.50(b) and 41.52(a)(1), we treat this new Decision as containing a new ground of rejection.

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REQUEST FOR REHEARING-GRANTED
37 C.F.R. § 41.50(b)

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